

5/29/02

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Paper No. 17
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WWWeb Impressions, LLC

Serial No. 75/595,241

Kirk M. Hartung of Zarley, McKee, Thomte, Voorhees & Sease
for WWWeb Impressions, LLC.

Anthony J. Tambourino,¹ Trademark Examining Attorney, Law
Office 107 (Thomas Lamone, Managing Attorney).

Before Cissel, Seeherman and Rogers, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

WWWeb Impressions, LLC has appealed from the final
refusal of the Trademark Examining Attorney to register
WWWEB IMPRESSIONS as a mark for "computer services, namely
design and implementation for others of global computer
network websites."² Registration has been refused pursuant
to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on

¹ Mr. Tambourino prepared the brief in this case; a different
Examining Attorney handled the examination of the application.

² Application Serial No. 75/595,241, filed November 25, 1998,
and asserting a bona fide intention to use the mark in commerce.

the ground that applicant's mark so resembles the mark NETIMPRESSIONS, previously registered for "computer services provided through a global computer network, namely designing, implementing, and maintaining web sites for others"³ as to be likely, if used in connection with applicant's identified services, to cause confusion or mistake or to deceive. The Examining Attorney has also made final a requirement, pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. 1056(a), that applicant disclaim exclusive rights to WWWEB.

The appeal has been fully briefed, but an oral argument was not held.⁴

Turning first to the requirement for a disclaimer, Section 6(a) of the Trademark Act provides, in part, that "the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable."

³ Registration No. 2,182,951, issued August 18, 1998.

⁴ It is noted that in the middle of page 13 of applicant's 14-page main brief there is a request for oral argument. Trademark Rule 2.142(e)(1) specifically provides that "if the appellant desires an oral hearing, a request therefore should be made by a separate notice...." (emphasis added.) Throughout the course of this appeal applicant has failed to comply with the Trademark Rules governing appeals, e.g., failing to file its main brief within 60 days of the filing of the notice of appeal and failing to file its reply brief within 20 days from the mailing of the Examining Attorney's brief. Trademark Rule 2.142(b). Although the Patent and Trademark Office has excused the latter lapses, the Board will not excuse applicant's failure to follow the procedure set forth in the rule to request an oral hearing, and will therefore not schedule one in this appeal.

A term which is merely descriptive of the goods or services is unregistrable under Section 2(e)(1) of the Act.

It is the Examining Attorney's position that WWWEB is merely descriptive of applicant's design and implementation of global computer network websites because it is the acronym WWW, with the final word represented by the acronym, i.e., WEB, spelled out. Applicant, on the other hand, asserts that WWWEB is not a word that can be found in a dictionary, nor is it commonly associated with goods or services in applicant's field.

We affirm the Examining Attorney's requirement that WWWEB be disclaimed. The Examining Attorney has submitted dictionary evidence⁵ that "WWW" is defined as "World Wide Web; a hypertext-based system for finding and accessing resources on the Internet network," and that "World Wide Web" is further defined as:

Also called WEB or W3. The World Wide Web is the universe of accessible information available on many computers spread through the world and attached to that gigantic computer network called the Internet. The Web has a body of software, a set of protocols and a set of defined conventions for getting at the information on the Web. The Web uses hypertext and multimedia techniques to make the web easy for anyone to roam, browse and contribute to. The Web makes publishing

⁵ Newton's Telecom Dictionary, 15th ed. © 1999.

information (i.e., making that information public) as easy as creating a "home page" and posting it on a server somewhere in the Internet. Pick up any Web access software (e.g. Netscape), connect yourself to the Internet (through one of many dial-up, for-money, Internet access providers or one of the many free terminals in Universities) and you can discover an amazing diversity of information on the Web. From weather to stock reports to information on how to build nuclear bombs to the best tennis tips, it can be posted on the Web for all to read. Invented by Tim Berners-Lee at CERN, the Web is the first true "killer app" of the Internet.

It is clear that "World Wide Web" is merely descriptive of a characteristic of applicant's services, which is to design and implement websites which are accessed through the World Wide Web. Although the term WWWEB is not found in the computer dictionary, the terms "WWW" and "World Wide Web" are widely recognized, and applicant itself acknowledges that these terms are commonly used. Reply brief, p. 1. Because of this widespread recognition, and because WWWEB begins with the commonly known term "WWW," with the word represented by the last "W" spelled out as "WEB," so as to reinforce the meaning of WWW, anyone who would be interested in applicant's services would immediately understand WWWEB to mean the World Wide

Web, and to understand the descriptive significance of WWWEB.

Turning next to the question of likelihood of confusion, our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant's services, design and implementation of global computer network websites and the registrant's services, designing, implementing and maintaining web sites for others, are legally identical, a fact which applicant does not dispute. Accordingly, not only are the respective services the same, but they also must be deemed to be offered through the same channels of trade to the same classes of customers.

This brings us to a consideration of the marks, keeping in mind that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of**

America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant's mark is WWWEB IMPRESSIONS, while the cited mark is NETIMPRESSIONS. Both end with the identical term IMPRESSIONS, and begin with a term which describes the services. As noted previously, WWWEB would be perceived by consumers as referring to the fact that the websites applicant designs and implements are on the web. NET, too, would be recognized as referring to the Internet, and consumers would understand that the websites the registrant designs and implements are on the Internet. Thus, although the marks start with terms that are different in appearance and pronunciation, because of the descriptive significance of the initial terms, and the similarity of their connotations, these differences are not sufficient to distinguish the marks as a whole. Rather, the marks both convey similar commercial impressions

It is well-established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For the aforesaid reasons, the IMPRESSIONS part of both marks has

greater source-identifying significance, and the marks in their entireties are similar because of their overall connotations, namely of the word IMPRESSIONS preceded by terms referring to the location of the websites on the World Wide Web or the Internet, and in their composition, with the descriptive term for the websites being followed by the word IMPRESSIONS. Accordingly, when WWWEB IMPRESSIONS is used for the same website design and implementation services as NETIMPRESSIONS, purchasers are likely to believe that these marks are mere variations on a theme, and that the services identified thereby emanate from the same source.

Although applicant notes that in many cases the courts and the Board have found that the first element of a trademark is more likely to be impressed on the mind of a purchaser and remembered, we do not find that to be the case here because of the descriptiveness of the initial portions of both applicant's and the registrant's marks. The cases cited by applicant are not persuasive.

Applicant also argues that the cited mark is entitled to a limited scope of protection because there are third-party marks in the same field. In support of this argument, applicant has made of record five third-party

registrations which include the word IMPRESSIONS.⁶ Of these five registrations, four are for goods that are very different from the services identified in the application and cited registration, being for computer software programs for business graphics charting software applications; for computer software programs for image and text storage; for computer monitors; and for catalogs for computer printers. We do not consider these registrations to be for goods similar enough to the cited registrant's services to conclude the scope of protection for the cited registration should be limited. Even if we were to find that the scope of protection to be afforded the cited registration would not extend to different kinds of computer products, the scope of protection certainly would extend to the identical services covered by the cited registration.

There is one third-party registration for services that are essentially the same as those in the cited registration and in applicant's application, namely, GLOBAL IMPRESSIONS for "web site design and development services."⁷ There has been speculation by the Examining Attorney and

⁶ Applicant refers to six registrations in its brief, but one of these registrations is the cited registration.

⁷ Registration No. 2,193,915.

the applicant as to why this registration issued despite the presence of the cited registration on the Register. However, the file of that registration is not of record, and we cannot determine why the registrations were found acceptable for coexistence on the Register. What we can say is that the commercial impression of GLOBAL IMPRESSIONS is not as similar to the cited mark NETIMPRESSIONS as WWWEB IMPRESSIONS is. Further, even if we were to assume that the scope of protection to be accorded the NETIMPRESSIONS mark is not broad enough to extend to the mark GLOBAL IMPRESSIONS, we still find it to extend to prevent the registration of the more similar mark WWWEB IMPRESSIONS.

Decision: The refusal on the ground of likelihood of confusion and the requirement for a disclaimer of WWWEB are affirmed. Applicant may, pursuant to Trademark Rule 2.142(g), submit the required disclaimer within 30 days of the mailing date of this decision, and that portion of the decision affirming the requirement for a disclaimer will be set aside.